



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/148,992	01/27/88	HESSEL	L

FISHER, CHRISTEN & SAROL
SUITE 510
2000 L STREET, N. W.
WASHINGTON, DC 20036

EXAMINER	
COSTANTINO, M	
ART UNIT	PAPER NUMBER
330	4

DATE MAILED:

07/25/88

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 1-27-88 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire (three) 3 month(s), 3 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 21-25 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 21-25 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable;
☐ not acceptable (see explanation).

10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received

☒ been filed in parent application, serial no. 07/058,766; filed on 6-5-88

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

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Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claim 23 is indefinite in that the terminology "adapted for insertion" does not define structure to support the functioning of the "second elastic ring" as claimed.

35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 24 and 25 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2 and 3 of prior U.S. Patent No. 4,735,621. This is a double patenting rejection.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 21 and 22 are rejected under 35 U.S.C. 103 as being unpatentable over "The Bee Gee Company" brochure in view of Dyck et al.

The "Bee Gee" brochure shows everything claimed except making the sheath from a material selected from the group consisting of polyethylenes, polyurethanes and derivatives thereof. Dyck et al show that it is known in the art to make prophylactic sheaths from materials such as polyurethane because they allow the sheath to be made "thin enough so as not to impair movement or feeling ... but strong enough to prevent the formation of pinholes". (see column 1 lines 36-41). It would have been obvious to one of ordinary skill in the art to construct the prophylactic sheath of "Bee Gee" from polyurethane in view of Dyck et al in order to make the sheath thin enough so as not to impair movement and sensation but strong enough to prevent rupture.

Claim 23 is rejected under 35 U.S.C. 103 as being unpatentable over "The Bee Gee Company" brochure in view of Dyck et al as applied to claim 22 above, and further in view of Graham.

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The device of "Bee Gee" does not contain a second ring within the closed end to prevent displacement of the device from a female using the device.

Graham teaches placing a resilient ring 1, within a tubular semen collecting sheath to maintain the sheath within a female.

It would have been obvious to one of ordinary skill in the art to place a resilient ring in the closed end of the sheath of "Bee Gee" in order to maintain the sheath in place within a female in view of Graham.

Claims 22 and 23 are rejected under 35 U.S.C. 103 as being unpatentable over Graham in view of Dyck et al.

Graham shows a tubular protective device made from a thin-walled flexible tube having open and closed ends and an outwardly extending "collar-shaped means" 7, 8 which radially stretches the open end to prevent the entire device from entering a user of the device and a second ring 1 for maintaining the closed end of the device within a user of the device. The sheath of Graham differs from applicant's claimed sheath in that it is not made from polyurethane. Dyck et al teach making tubular sheaths from polyurethane because such a material allows the sheath to be made thinner than previous sheaths and thus increases sensation felt by

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users of the sheath. It would have been obvious to one of ordinary skill in the art to make the sheath of Graham from polyurethane in view of Dyck et al so as to prevent the impairment of sensation felt by users of the device.

The Abstract is objected to because it contains legal phraseology such as "means". Correction is required. See MPEP 608.01(b).

Any inquiry concerning this communication should be directed to Mario Costantino at telephone number 703-557-3125.

M. Costantino:mef

7-12-88 *MC*

C. Fred Rosenbaum
C. FRED ROSENBAUM
S. P. E.
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